

REMARKS

The Non-Final Office Action mailed September 11, 2009 and the references cited therein have been carefully considered. Claim 1-16 are now pending in the application. By this Response, Claims 1 and 14 are hereby amended and claims 17 and 19 are cancelled. The amendments to Claims 1 and 14 incorporate the limitations of cancelled dependent claims 17 and 19, respectively, in order to clarify that which Applicants regard as aspects of the invention. Thus, no new matter has been added by amendments to the claims.

Interview Summary

Applicants appreciate and respectfully acknowledge the brief telephone discussion that took place between Examiner Robert Grabowski and the undersigned on September 21, 2009. At that time, Examiner Grabowski clarified that the prior art rejection noted on page 3, paragraph 4 of the subject Office Action was intended to include a rejection of all pending claims. Accordingly, for purposes of this Response Applicants have interpreted that rejection as being directed toward all pending claims 1-20.

Claim Rejections under 35 USC §103

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent No. 1,398,174 to **Moreau** in view of U.S. Published Patent Application 2005/0040641 to **Cote et al.** Applicants traverse this rejection and respectfully request reconsideration and withdrawal of the pending rejections of the claims herein.

Applicants' prior responses to Office Actions described various aspects disclosed by Moreau and those arguments are hereby incorporated by reference. Further it should be noted that the primary gist of the Moreau disclosure is to provide a substrate having a zone of reduced thickness which is reinforced by means to increase the resistance of the reduced thickness zone (see Claim 1 of Moreau.) In the subject Office Action at paragraph 5, the Examiner points out that Moreau at paragraph [0009] makes reference to PCT Application WO 95/10420 to **Herrmann**. In particular, Herrmann discloses covering a hole in a substrate with a strip of foil or laminate. However, it should be noted that the Herrmann disclosure refers to sealing such a substrate hole on the same side as a film support and not an opposed side as recited in the pending claims. What is more, Moreau teaches away from providing such a hole in the substrate in order to achieve the object of the invention which is to provide a reinforced zone upon which further printing can be done directly and easily. The Examiner's attention is directed to paragraph [0020] of Moreau where it specifically discloses that an object of the invention is to overcome the technical prejudices which make it not possible to print matter on the zone of reduced thickness because of fragility. Clearly, a through hole would be an extreme example of a zone of reduced thickness in this regard and thus, Moreau teaches away from such a structure.

Even if one of ordinary skill were to cut a through hole in a substrate media as taught by Herrmann and in a negative sense by Moreau, there is no teaching in the art to apply a sealing layer in the form of a lacquer to a side of the paper support that is opposite to the relationship of the film element as recited in the claims.

The subject Office Action further cites Cote for the teaching of providing a protective lacquer layer of a particular composition. However, particular attention should be directed to the structural configuration of layers in Cote. In particular, Cote includes a support layer 12, an information bearing layer 14 formed on the support layer surface and a protective layer 24 applied to the information bearing layer 14. The sealing of the support layer 12 and the protective layer 24 along opposing longitudinal borders 18a, 18b adjacent to the information bearing layer 14, prevents corrosive and/or degrading materials from reaching the information bearing layer 14 through these sealed borders 18a, 18b. As a result, the information conveyed by way of the information bearing layer 14 and thus the integrity of the security device is preserved. Cote uses a protective layer 24 of a security element applied by a printing method, and that a security thread is produced and disposed in a completely finished state on or within a document (see paragraphs [0054] – [0056].)

Contrary to the suggestion in the subject Office Action, Cote does not disclose or reasonably suggest applying the “printed coating” 24 after mounting the security thread 10 in or on the document. Further, the subject Office Action at the bottom of page 5 refers to Cote as specifically teaching that a lacquer “fully encapsulates” the material to be protected. However, in paragraphs [0052] - [0054] of Cote, it is unambiguously disclosed that the security thread is produced and disposed, in a completely finished state on or within a document. The protective coating (e.g. printed coating) will only come into contact with the substrate of the security document in a finished and firm/non-liquid state. Again, in Cote the printed thread 10 (shown in Figs. 1-10) is fully formed before being embedded or applied to the surface of a security

document. Therefore, Cote could not be said to disclose that the printed coating is directly applied to at least one portion of cut edges forming inner surfaces of a through hole of the document as recited in the claims.

Further, Cote simply does not disclose or suggest applying a thick and viscous coating of lacquer on a document through-hole from an opposed side of that which a film element covering the through-hole is applied. Thus, it is further submitted that the combination of Moreau and/or Herrmann and Cote fails to teach or reasonably disclose all the limitations of the claimed invention, nor would it be obvious for one of ordinary skill to alter those teachings to arrive at the aspects of the invention as currently recited in the claims.

Accordingly, the combination of Moreau and Cote fails to meet all the limitations of the claimed invention. In view of the foregoing remarks, Applicants respectfully request reconsideration and allowance of the claims presented.

Conclusion

Applicants submit that the amended claims, particularly independent Claims 1 and 14, and Claims 2-13, 15, 16, 18 and 20-22 which ultimately depend from Claims 1 and 14, are similarly patentable over the art of record by virtue of their dependence. Also, Applicants submit that Claims 1 and 14, and Claims 2-13, 15, 16, 18 and 20-22 define patentable subject matter in their own right.

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In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and allowance of the claims presented. If the Examiner has any questions or suggestions to expedite allowance of this application, he is cordially invited to contact Applicants' attorney at the telephone number provided.

Respectfully submitted,

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